

RECEIVED
CENTRAL FAX CENTER

DEC 21 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Date: -December 21, 2006

Applicants: Bednorz et al.

Docket: YO987-074BZ

Serial No.: 08/479,810

Group Art Unit: 1751

Filed: June 7, 1995

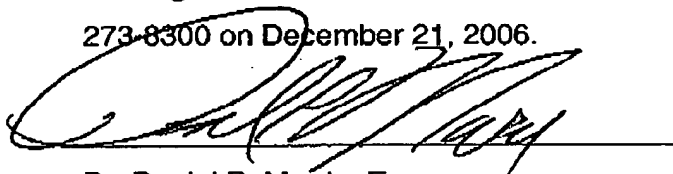
Examiner: M. Kopec

For: **NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH TRANSITION
TEMPERATURE, METHODS FOR THEIR USE AND PREPARATION**

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Eighth Response After Final Rejection (3 pages)
is being facsimile transmitted to the U.S. Patent and Trademark Office to (571)
273-8300 on December 21, 2006.



Dr. Daniel P. Morris, Esq.
Reg. No. 32,053

**FIRST SUPPLEMENTARY
APPEAL BRIEF**

Sir:

In addition to the arguments in the Brief submitted on 11/27/2006
Pursuant to 35 U.S.C. 134 and 37 C.F.R. 41.37 Applicants add the following
comments.

Serial No.: 08/479,810

1

Supplementary Comments To**Part VII****CFR 37 §41.37(c)(1)(vii)****Argument****RECEIVED
CENTRAL FAX CENTER****DEC 21 2006**

At page 59 of the Brief submitted on 11/27/2006 Applicants note that the Examiner states at page 6 of Office Action dated 07/28/2004:

Small changes in composition can result in dramatic changes in or loss of superconducting properties.

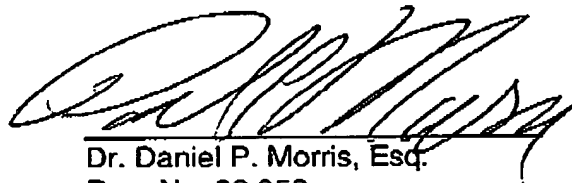
The Examiner cites no authority for why this statement is relevant to whether Applicants' claims are enabled. Arts that are usually considered predictable within the meaning of the US patent law are the mechanical and electrical arts. A mechanical apparatus is made up of gears, wheels, lever arms, etc. A small change in the size of one of these elements of a mechanical apparatus can result in the apparatus not functioning. An electrical apparatus is made up of resistors, capacitors, inductors, etc. A small change in the magnitude of one of these elements of an electrical apparatus can result in the apparatus not functioning. Thus that small changes in the value or magnitude of constituent elements of an invention can result in that apparatus not working is not prima facie evidence of lack of enablement as the Examiner's statement from page 6 of Office Action dated 07/28/2004 suggests. In actual fact, the Examiner's comment implies enablement. By stating that "[s]mall changes in composition can result in dramatic changes in or loss of superconducting properties" the Examiner is, in fact, acknowledging that the compositions can be made and tested to determine whether the composition has the desired superconducting property. This is all that enablement requires. Thus the Examiner's statement quoted above supports the enablement of Applicants' claims. As stated in the Brief, to satisfy the enablement requirement, an Applicant does not have to foresee all species that come within the scope of Applicants' claims.

Volume 3 of Applicants' Brief refers to the Examiner's First, Second and Third Enablement Statements. The Examiner's statement that "[s]mall changes in composition can result in dramatic changes in or loss of superconducting properties" is an Examiner's Fourth Enablement Statement.

The Examiner has provided not evidence or argument that a species that comes within the scope of Applicants' claims exists, or can be made, but cannot be made and determined to have the high Tc superconductive property following Applicants teaching, when viewed from the point of view of a person or ordinary skill in the art as of Applicants earliest priority date. Thus the Examiner has not made out a prima facie case of lack of enablement. In view thereof Applicants request the Board to reverse the rejections of Applicants' claims for lack of enablement.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

Respectfully submitted,



Dr. Daniel P. Morris, Esq.
Reg. No. 32,053
(914) 945-3217

IBM CORPORATION
Intellectual Property Law Dept.
P.O. Box 218
Yorktown Heights, New York 10598